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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,539	07/27/2001	R. Dennis Nesbitt	P-3611-2-D1-3-C1 SLD 2 01	3362

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EXAMINER
DUONG, THANH P

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/917,539	NESBITT ET AL.	
	Examiner	Art Unit	
	Tom P Duong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 2, 3, 4, 5, 6, 7 & 22, 8, 9, 19, and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2-3, 2, 3, 4, 5, 1, 6, 6, 1, and 1 of U.S. Patent No. (Sullivan et al.) 6,142,887, respectively, in view of Sullivan et al. (5,368,304). Claims 1, 19, and 28 of the U.S. patent '887 claims substantially the same subject matter as claim 1 of the instant application, except for a core having a Riehle compression of at least about 75 and a cover having a Shore D hardness of at least about 65. However, the composition disclosed in U.S. patent '887 is similar to the composition as claimed by the Applicant. Thus, U.S. patent '887 inherently has the same properties as claimed by the Applicant. Furthermore, Sullivan '304 discloses a golf ball similar to the instant application with a compression of at least 0.075 and a cover having a Shore D hardness of at least 65 (Col. 4, lines 34-37) in order to provide a golf ball with a lower than anticipated spin rate while maintaining high resilience and good durability. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide a golf ball of U.S. patent

'887 with the properties as taught by Sullivan '304 to gain the advantage of lower spin rate, maintain resilience, and good durability.

2. Claims 13, 14 & 30, 15, 16, 17, and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, 4, 5, 6, and 7 of U.S. Patent No. 6,142,887, respectively, in view of Sullivan et al. (5,368,304) and Examiner Official Notice. Claims 13-18 and 28 discloses a golf ball and a cover composition similar with structure to Sullivan U.S. patent '887 and '304 but patent '887 does not disclose the cover thickness and the golf ball diameter. Examiner takes Official Notice that it would have been obvious in view of one having ordinary skill in the art at the time the invention was made to duplicate the golf ball of Patent '887 to have the cover thickness and diameter as taught by patent '304 since both patent have the same composition and structure.

3. Claims 24, 25, 26, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 11, and 12 of U.S. Patent No. 6,142,887, respectively, in view of Sullivan et al. (5,368,304) and Examiner Official Notice. Claims 24-27 discloses a golf ball with similar composition and structure to Sullivan U.S. patent '887 and '304 but patent '887 does not disclose the core Riehle compression and diameter. Examiner takes Official Notice that it would have been obvious in view of one having ordinary skill in the art at the time the invention was made to duplicate the golf ball of Patent '887 to have Riehle compression and diameter as taught by patent '304 since both patent have the same composition and structure.

4. Claims 10 and 23, 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the references applied in claim 1, and further in view of Sullivan et al. (5,820,489). Claims 10 and 23, 12 claim substantially the same subject matter or same composition as claim 1 of U.S. patent '489. This composition provides a hard cover that improves durability. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have a cover composition of Sullivan described in claim 1 similar to a cover composition as taught by Sullivan '489 to obtain a cover with improved durability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9302 for regular communications and (703) 746-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4119.

Tom Duong
May 21, 2002

Paul T. Sewell
Supervisory Patent Examiner
Group 3700